

REMARKS

This Response is to the final Office Action dated February 1, 2005. Claims 1 to 32 are pending in the present application. Due to a Restriction Requirement, Claims 1 to 9 have been elected and examined and Claims 10 to 32 have been withdrawn from consideration. Claims 1 to 9 stand rejected. Claim 1 has been amended herein. Claims 33 to 41 have been added. A check in the amount of \$1100.00 is submitted herewith to cover the cost of the added claims and extension of time. Please charge Deposit Account No. 02-1818 for any additional fees.

In the Office Action, Claims 1 to 3 and 7 to 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,294,374 to Martinez et al. ("*Martinez*"). Claims 1 to 6 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by WO 96/02922 to Schrier et al. ("*Schrier*"). Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Schrier* and U.S. Patent No. 4,726,991 to Hyatt et al. ("*Hyatt*").

It is clear from a thorough reading of *Martinez* that "self-supporting" as used in that application means having a viscosity sufficient so that the material can hold itself together and NOT the voltage variable substrate of the present invention, which has a solid state in which the insulative binder is: (i) free standing; (ii) sufficiently rigid to support and be packaged with at least one electrical component; and (iii) the conductive particles impregnated into the binder are operable to protect the component from an electrostatic discharge event.

Martinez simply does not teach or suggest such a claim. The cited passages do not hint at the presently presented claim. The Abstract and column 3, lines 60 to 63 merely indicate that the *Martinez* material can be molded into a coherent shape. There is no suggestion that the material is: (i) free standing; (ii) sufficiently rigid to support and be packaged with at least one electrical component; and (iii) wherein the conductive particles impregnated into the binder can thereafter protect the component from an electrostatic discharge event.

Column 18, lines 56 to 59 specifies thicknesses for the *Martinez* material. There is no hint or suggestion here that the material is: (i) free standing; (ii) sufficiently rigid to support and be packaged with at least one electrical component; and (iii) wherein the conductive particles impregnated into the binder can thereafter protect the component from an electrostatic discharge event. Likewise, Example 1 of *Martinez* merely says that the material can be cut into strips. It does not teach the elements of Claim 1.

The Abstract of *Martinez* indicates that its invention to a power outlet strip with surge arresting components. There is no suggestion here to provide a material with the above-cited characteristics. Besides the silicone rubber sheets, *Martinez* discusses ceramic based binders generally at column 7, which are taught to moldable putty or adhesive (column 7, line 18 and associated chart). Again, there is no suggestion of the claimed material.

Regarding *Schrier*, it is clear just from its Abstract that the purpose of its material's reinforcing layer is to resist compressive forces caused when it is placed in an application, NOT to provide a material that is: (i) free standing; (ii) sufficiently rigid to support and be packaged with at least one electrical component; and (iii) wherein the conductive particles impregnated into the binder can thereafter protect the component from an electrostatic discharge event.

The Background of *Schrier* at pages 3 and 4 makes clear that the problem it is attempting to address is to "have the voltage variable material be continuous across at least one of the surfaces of the variable voltage protection component ..." (page 4, line 15). That quote implies that the *Schrier* material is spread across a component and is not: (i) free standing; (ii) sufficiently rigid to support and be packaged with at least one electrical component; and (iii) wherein the conductive particles impregnated into the binder can thereafter protect the component from an electrostatic discharge event.

The cited passages of *Schrier* (page 4, lines 16 to 18; page 8, lines 28 to 31; and page 9, lines 20 to 22) each discuss aspects of the reinforcing layer. The purpose of the reinforcing layer is to "define[s] a uniform thickness for the variable voltage protection component that is resistant to compressive forces that may cause a reduction in the clamp voltage or a short in the voltage variable material." (page 4, line 19). Again, no hint or suggestion is made to provide a material as claimed in the present invention.

Because *Martinez* and *Schrier*, alone or in combination do not make out a prima facie case of anticipation and provide no hint as to the desirability of the present invention, Applicant respectfully submits that Claim 1 and Claims 2 to 9 depending from Claim 1 are patentable over *Martinez* and *Schrier*. The patentability of Claim 1 renders moot the obviousness rejection of Claims 7 and 8.

New Claims 33 to 41 are patentable over *Martinez* and *Schrier* for at least some of the reasons described above. Moreover, there is no hint or suggestion in those references to provide a printable voltage variable material substrate, which can accept multiple circuit traces.

Applicants therefore submit respectfully that Claim 33 and Claims 34 to 41 depending from Claim 33 are patentable over *Martinez* and *Schrier*.

For the foregoing reasons, Applicant respectfully submits the this case is now in condition for allowance.

Respectfully submitted,

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